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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/821,184	03/29/2001	Kenneth A. Parulski	75276CRC	6403

7590 12/18/2002

Thomas H. Close
Patent Legal Staff
Eastman Kodak Company
343 State Street
Rochester, NY 14650-2201

EXAMINER

LAMB, TWYLER MARIE

ART UNIT

PAPER NUMBER

2622

DATE MAILED: 12/18/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/821,184

Applicant(s)

PARULSKI ET AL.

Examiner

Twyler M. Lamb

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 October 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) _____ is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-2, 5-6, 9-10, 13-14 and 17 are rejected under 35 U.S.C. 102(b) as being anticipated by Sarbadhikari et al. (US 5,477,264).

With regard to claim 1, Sarbadhikari et al. discloses an electronic printing system (Figure 1, electronic still photography system, col 4, lines 1-6) for printing images stored on a removable memory card (removable memory card 3), the electronic printing system (Figure 1, col 4, lines 1-6) comprising: a memory card interface (memory card slot 2) for receiving the removable memory card (col 4, lines 2-6), the removable memory card (removable memory card 3) having stored thereon a plurality of digital image files (col 4, lines 6-9) and a print utilization file (col 4, lines 37-42), the print utilization file (col 4, lines 37-42) identifying at least two digital images files stored on the removable memory card to be printed (which reads on the memory card containing data files, therefore there would be at least two data files stored on the memory card) (col 4, lines 37-42), the at least two digital image files corresponding to selected ones of a plurality of digital images captured by a digital camera adapted to receive the removable memory card (which reads on the memory card containing data files, therefore there

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would be at least two data files stored on the memory card) (col 4, lines 37-42); a processor (built-in memory card reader 5; col 4, lines 2-6) coupled to the memory card interface (memory card slot 2) for reading the print utilization files stored on the removable memory card (removable memory card 3) and the digital image files identified in the print utilization file (col 4, lines 37-42); a print engine (printer 6) coupled to the processor for producing prints of the at least two stored digital files identified in the print utilization file (col 10, lines 12-23).

With regard to claim 10, Sarbadhikari et al. discloses a method (Figure 1, electronic still photography system, col 4, lines 1-6) for printing images stored on a removable memory card (removable memory card 3), the method comprising the steps of: providing a removable memory card (removable memory card 3) having stored thereon a plurality of digital image files (col 4, lines 6-9) and a print utilization file (col 4, lines 37-42), the print utilization file (col 4, lines 37-42) identifying at least two digital files stored on the removable memory card (removable memory card 3) to be printed (which reads on the memory card containing data files, therefore there would be at least two data files stored on the memory card) (col 4, lines 37-42), the at least two digital image files corresponding to selected ones of a plurality of digital images captured by a digital camera adapted to receive the removable memory card (which reads on the memory card containing data files, therefore there would be at least two data files stored on the memory card) (col 4, lines 37-42); reading (built-in memory card reader 5; col 4, lines 2-6) the print utilization file (col 4, lines 37-42) stored on the removable memory card (removable memory card 3) and the digital image files identified in the print utilization

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file (which reads on the memory card containing data files, therefore there would be at least two data files stored on the memory card) (col 4, lines 37-42); and producing prints of the at least two stored digital image files identified in the print utilization file (col 10, lines 12-23).

With regard to claim 2, Sarbadhikari et al. also discloses further including an internal memory (image buffer 18) for storing at least a portion of one digital image file to be printed (col 10, lines 9-58).

With regard to claim 5, Sarbadhikari et al. also discloses wherein the print utilization file further includes the file type of each digital image file (which reads on the stored image signals being of the JPEG type) (col 6, lines 26-37).

With regard to claim 6, Sarbadhikari et al. also discloses wherein the file type of at least one digital file is a JPEG file type (col 6, lines 26-37).

With regard to claim 9, Sarbadhikari et al. also discloses wherein the print utilization file further identifies a template to be combined with a particular digital image file to form a composite image to be printed (col 10, lines 24-53).

With regard to claim 13, Sarbadhikari et al. also discloses wherein the print utilization file further includes the file type of each digital image file (which reads on the stored image signals being of the JPEG type) (col 6, lines 26-37).

With regard to claim 14, Sarbadhikari et al. also discloses wherein the file type of at least one digital file is a JPEG file type (col 6, lines 26-37).

With regard to claim 17, Sarbadhikari et al. also discloses wherein the print utilization file further identifies a template to be combined with a particular digital image file to form a composite image to be printed (col 10, lines 24-53).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 3-4 and 11-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sarbadhikari et al. (US 5,477,264) in view of Ito (US 6,373,592).

With regard to claim 3, Sarbadhikari et al. does not clearly teach wherein the print utilization file further includes the quantity of prints to be printed for each digital image file.

Ito discloses an image file generating apparatus that includes wherein the print utilization file further includes the quantity of prints to be printed for each digital image file (col 3, lines 63-67).

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Sarbadhikari et al. to include wherein the print utilization file further includes the quantity of prints to be printed for each digital image as taught by Ito. It would have been obvious to one of ordinary skill in the art at the time

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of the invention to have modified Sarbadhikari et al. by the teaching of Ito to output the prints based thereon as taught by Ito in col 3, lines 63-67.

With regard to claim 4, Sarbadhikari et al. does not clearly teach wherein the print utilization file further includes the size of the prints to be printed for each digital image file.

Ito discloses an image file generating apparatus that includes wherein the print utilization file further includes wherein the print utilization file further includes the size of the prints to be printed for each digital image file (col 3, lines 63-67).

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Sarbadhikari et al. to include wherein the print utilization file further includes the size of the prints to be printed for each digital image file as taught by Ito. It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Sarbadhikari et al. by the teaching of Ito to output the prints based thereon as taught by Ito in col 3, lines 63-67.

With regard to claim 11, Sarbadhikari et al. does not clearly teach wherein the print utilization file further includes the quantity of prints to be printed for each digital image file.

Ito discloses an image file generating apparatus that includes wherein the print utilization file further includes the quantity of prints to be printed for each digital image file (col 3, lines 63-67).

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Sarbadhikari et al. to include wherein the print

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utilization file further includes the quantity of prints to be printed for each digital image as taught by Ito. It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Sarbadhikari et al. by the teaching of Ito to output the prints based thereon as taught by Ito in col 3, lines 63-67.

With regard to claim 12, Sarbadhikari et al. does not clearly teach wherein the print utilization file further includes the size of the prints to be printed for each digital image file.

Ito discloses an image file generating apparatus that includes wherein the print utilization file further includes wherein the print utilization file further includes the size of the prints to be printed for each digital image file (col 3, lines 63-67).

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Sarbadhikari et al. to include wherein the print utilization file further includes the size of the prints to be printed for each digital image file as taught by Ito. It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Sarbadhikari et al. by the teaching of Ito to output the prints based thereon as taught by Ito in col 3, lines 63-67.

5. Claims 7-8 and 15-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sarbadhikari et al. (US 5,477,264) in view of Ohtuska (US 6,198,526).

With regard to claim 7, Sarbadhikari et al. does not clearly teach wherein the print utilization file further includes a customer name and a mailing address of such customer.

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Ohtuska discloses a method of storing film information that includes wherein the print utilization file further includes a customer name and a mailing address of such customer (Figure 7, col 9, lines 3-20).

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Sarbadhikari to include wherein the print utilization file further includes a customer name and a mailing address of such customer as taught by Ohtuska. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Sarbadhikari et al. by the teaching of Ohtuska to insure the film units are customized as taught by Ohtuska in col 9, lines 23-20.

With regard to claim 8, Sarbadhikari et al. does not clearly teach wherein the print utilization file further includes a credit card number of the customer.

Ohtuska discloses a method of storing film information that includes wherein the print utilization file further includes a credit card number of the customer (which reads on the order information) (col 9, lines 52-61).

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Sarbadhikari et al. to include wherein the print utilization file further includes a credit card number of the customer as taught by Ohtuska. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Sarbadhikari et al. by the teaching of Ohtuska to insure proper identification of user before as taught by Ohtuska in col 9, lines 52-61.

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With regard to claim 15, Sarbadhikari et al. does not clearly teach wherein the print utilization file further includes a customer name and a mailing address of such customer.

Ohtuska discloses a method of storing film information that includes wherein the print utilization file further includes a credit card number of the customer (which reads on the order information) (col 9, lines 52-61).

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Sarbadhikari et al. to include wherein the print utilization file further includes a credit card number of the customer as taught by Ohtuska. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Sarbadhikari et al. by the teaching of Ohtuska to insure proper identification of user before as taught by Ohtuska in col 9, lines 52-61.

With regard to claim 16, Sarbadhikari et al. does not clearly teach wherein the print utilization file further includes a credit card number of the customer.

Ohtuska discloses a method of storing film information that includes wherein the print utilization file further includes a credit card number of the customer (which reads on the order information) (col 9, lines 52-61).

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Sarbadhikari et al. to include wherein the print utilization file further includes a credit card number of the customer as taught by Ohtuska. It would have been obvious to one of ordinary skill in the art at the time the

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invention was made to have modified Sarbadhikari et al. by the teaching of Ohtuska to insure proper identification of user before as taught by Ohtuska in col 9, lines 52-61.

Response to Arguments

6. Applicant's arguments filed 10/7/02 have been fully considered but they are not persuasive.

Applicant argues that Sarbadhikari does not disclose the claimed print utilization file as set forth in independent claims 1 and 10. Applicant argues that the portion of Sarbadhikari does not disclose a print utilization file that identifies "at least two digital image files...to be printed as set forth in independent claims 1 and 10.

Sarbadhikari discloses the print utilization file identifying at least two digital images files stored on the removable memory card to be printed (which reads on the memory card containing data files, therefore there would be at least two data files stored on the memory card) (col 4, lines 37-42).

Applicant's arguments with respect to claims 3-4, 7-8, 11-12 and 115-16 have been considered but are moot in view of the new ground(s) of rejection.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Twyler Lamb whose telephone number is 703 - 305-8823. The examiner can normally be reached on M-TH (8:30-5:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward L Coles can be reached on 703-305-4712. The fax phone numbers

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for the organization where this application or proceeding is assigned are 703-746-6036
for regular communications and 703-872-9314 for After Final communications.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, DC 20231

or faxed to:

(703) 872-9314

(for informal or draft communications, such as proposed amendments to be
discussed at an interview; please label such communications "PROPOSED" or
"DRAFT")

or hand-carried to:

Crystal Park Two
2121 Crystal Drive
Arlington, VA.
Sixth Floor (Receptionist)

Twyler Lamb



December 16, 2002

MARK WALLERSON
PRIMARY EXAMINER

